

REMARKS/ARGUMENTS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and discussion presented herein. The Applicant notes that this case was only recently assigned to the current Examiner, and that the prior Examiner issued the outstanding Office Action. Accordingly, the following remarks are directed to examination by the prior Examiner.

1. Withdrawal of Rejection of Claims 1-10 and 17-24.

The Applicant notes with appreciation the Examiner's withdrawal of the rejection of Claims 1-10 and 17-24 under 35 U.S.C. §102 based on Satomi et al. (U.S. Pat. Publ. No. 2003/0063304) in view of the Applicant's prior response. The Applicant further notes with appreciation that the Examiner accepted the Applicant's arguments that those claims were not rendered obvious by Satomi et al.

2. Rejection of Claims 1-10 and 17-28 under 35 U.S.C. § 103.

Claims 1-10 and 17-28 were rejected herein under 35 U.S.C. § 103 as being obvious in view of the combined teachings of Satomi et al. (U.S. Pat. Publ. No. 2003/0063304) and Lamkin et al. (U.S. Pat. Publ. No. 2006/0159109) Claims 1, 10, 17, and 26-28 are independent.

The Applicant respectfully traverses the rejection for the following reasons.

(a) The cited combination is not prior art against the Applicant's pending claims. The instant application was filed on 02/04/2004. However, Lamkin et al. which is the secondary reference cited by the Examiner, was published on 07/20/2006 based on an application filed on 12/16/2005.

Therefore, Lamkin et al. cannot be cited against the instant application unless the teachings of Lamkin et al. relied upon by the Examiner in support of the rejection can be found in, and are enabled by, either of the two prior patent applications from which Lamkin et al. claims priority that have filing dates prior to the instant application. The two priority applications having filing dates prior to the instant application are USSN 09/656,533 filed on 09/07/2000 and USSN 60/531,585 filed on 12/19/2003.

Yet, the Examiner did not even address the teachings of either of the two priority documents having filing dates prior to the instant application. Nor did the Examiner provide any basis for concluding that Lamkin et al. was in fact properly cited. Furthermore, the Applicant has not found the teachings of Lamkin et al. relied upon by the Examiner in support of the outstanding rejection in either of those two priority documents. Therefore, there is no basis for the Examiner asserting that Lamkin et al. is prior art against the instant application. The teachings of Lamkin et al. upon which the Examiner relies in support of the rejection cannot be used as a basis for rejection.

In view of the above, the Applicant respectfully submits that the rejection is based on an combination of references that does not constitute prior art, and requests that the rejection be withdrawn and that Claims 1-28 be allowed.

(b) Second, in the Applicant's prior response filed on 10/12/2006, the Applicant clearly demonstrated that Satomi et al. did not anticipate or render obvious any of pending Claims 1-28, which response is incorporated herein by reference in its entirety. The Examiner's then withdrew the rejection based on Satomi et al. alone, and located a new reference - namely, Lamkin et al. (which is not prior art as discussed above) to combine with Satomi et al. and provide the basis for an obviousness rejection. Yet, even the cited combination does not teach or suggest the invention recited in the Applicant's claims because (i) the Applicant's claims recite subject matter that is not taught by Satomi et al., and (ii) Lamkin et al. does not teach that which Satomi et al. fails to teach.

More particularly, the Examiner failed to make out a prima facie case of obviousness based on the combined teachings of Satomi et al. and Lamkin et al. as required by MPEP § 706.02(j), which requires that the Examiner set forth:

- (a) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate,
- (b) the difference or differences in the claim over the applied reference(s),

(c) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and

(c) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

Yet, the Examiner clearly failed to provide any explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification. A mere conclusory statement, as in the Office Action, that the claims would have been obvious is not sufficient.

In addition, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

However, the Examiner did not even address the three criteria discussed above.

Furthermore, the initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985)

Yet, the Examiner neither explained why or how the references expressly or impliedly suggest the claimed invention, nor presented any reasoning, let alone a

convincing line of reasoning, as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. In view of the above, the Applicant respectfully submits that the Examiner failed to meet his burden for an obviousness rejection, and requests that the rejection be withdrawn and that Claims 1-28 be allowed.

(c) Lastly, with regard to Claim 10, the Examiner failed to take into account that the claim is written in means plus function form under 35 U.S.C. §112, sixth paragraph, and respectfully traverses the rejection of Claim 10 based on *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc).

In rejecting Claim 10, the Examiner made no specific fact findings as to the scope of equivalents for the four (4) means plus function elements in the claim. An examiner "construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure ... described therein, and equivalents thereof," *In re Donaldson*, 16 F.3d 1189, 1193 (Fed. Cir. 1994)(en banc). The Federal Circuit held that the *Donaldson* decision sets "a limit on how broadly the PTO may construe means-plus-function language under the rubric of 'reasonable interpretation.'" *Id.* at 1194. In other words, an examiner's claim interpretation is not "reasonable" if it is not based on the specification's description of the implementation of the means element of the claim. The court then said, "Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such [means-plus-function] language when rendering a patentability determination." *Id.* at 1195.

Here, as in *Donaldson*, the Examiner is required by statute to look to the Applicant's specification and construe the "means" language as referring to corresponding means disclosed in the specification and equivalents thereof." See *Id.* at 1195. However, the Examiner did not construe the means language of these claims, however. Nor did the Examiner find, on the basis of specific facts of record here, that

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the means disclosed in the Applicant's specification were equivalent to that of the cited references. Instead, the Examiner simply presumed equivalence.

In view of the above, the Applicant respectfully submits that the rejection of Claim 10 lacks proper foundation, and requests that the rejection be withdrawn and that Claim 10 be allowed.

3. Conclusion.

Based on the foregoing, the Applicant respectfully requests that the various grounds for rejection in the Office Action be withdrawn and that a Notice of Allowance be issued for Claims 1-10 and 17-28.

In the event any further matters remain at issue with respect to the present application, Applicants respectfully request that the Examiner please contact the undersigned below at the telephone number indicated in order to discuss such matter prior to the next action on the merits of this application.

Date: _____

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John P. O'Banion", with a stylized, flowing script.

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